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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/939,883	08/27/2001	Volker Breu	20725	4828

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HOFFMANN-LA ROCHE INC.
PATENT LAW DEPARTMENT
340 KINGSLAND STREET
NUTLEY, NJ 07110

EXAMINER	
TRUONG, TAMTHOM NGO	
ART UNIT	PAPER NUMBER

1624

DATE MAILED: 09/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/939,883	BREU ET AL.
	Examiner Tamthom N. Truong	Art Unit 1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-145 is/are pending in the application.
 - 4a) Of the above claim(s) 7, 39-47, 79-81, 87-91, and 97-145 is/are withdrawn from consideration.
- 5) Claim(s) 1-6, and 8-13 is/are allowed.
- 6) Claim(s) 14-17, 48, 49, 70, 75, 82, 83, and 92 is/are rejected.
- 7) Claim(s) 18-37, 50-69, 71-74, 76-78, 84-86, and 93-96 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4,6</u> . | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

1. Applicant's election with traverse of Group I in Paper No. 9 is acknowledged. The traversal is on the ground(s) that "restriction within a single claim cannot be sustained under 35 U.S.C §121. This is not found persuasive because the species in one group are clearly independent and patentable over those of the other groups. Applicant's attention is directed to MPEP 808.01(a) which states the following:

- a. *Where there is no disclosure of relationship between species (see MPEP§ 806.04(b)), they are independent inventions and election of one invention following a requirement for restriction is mandatory even though applicant disagrees with the examiner...Since the claims are directed to independent inventions, restriction is proper pursuant to 35 U.S.C. 121, and it is not necessary to show separate status in the art or separate classification.*
- b. M.P.E.P 809.02 is based on 37 C.F.R 1.146 which allows the examiner to make restriction requirement if more than one patentably distinct species are embraced by a generic claim (or genus).
- c. In the instant case, the combination of ring A² with either a quinoline or a quinazoline ring would amount to more than one patentably distinct species. Thus, the burden of searching exists.

The requirement is still deemed proper and is therefore made FINAL.

Claims 1-6, 8-38, 48-78, 82-86, and 92-96 (part of each) are pending. Claims 7, 39-47, 79-81, 87-91, and 97-145 are withdrawn from consideration as being drawn to the non-elected subject matter.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 14-17, 48, 49, 70, 75, 82, 83, and 92 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reasons apply:
 - d. Claims 14, 48, 70, 75, 82, 83, and 92 recite the limitation of “alkyl” for R⁸, which is indefinite because the term “alkyl” is a monovalent moiety (e.g., -CH₃) while R⁸ appears to represent a divalent moiety (e.g., -CH₂-).
 - e. Claims 15-17, 75, and 83 are rejected for being dependent on claim 14 (ultimately), and carrying over the limitation of R⁸ as “alkyl”.
 - f. Claim 49 lacks antecedent basis because it recites R⁹, which is not in formula Ia. Claim 49 is also rejected for dependent on claim 48, and carries over the limitations of claim 48.

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Claim Objections

3. Claims 18-37, 50-69, 71-74, 76-78, 84-86, and 93-96 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Allowable Subject Matter

4. Except for the non-elected subject matter, claims 1-6, and 8-13 are allowed. The following is a statement of reasons for the indication of allowable subject matter:

A search in the pertinent art yields three references (cited on PTO-892) that appear to bear relevant subject matter. However, their effective filing dates or publication dates do not antedate the effective filing date of the instant application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamthom N. Truong whose telephone number is 703-305-4485. The examiner can normally be reached on M-F (9:30-5:00) & every Saturday morning (starting from 4-7-03).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on 703-308-4716. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.



T. Truong

September 2, 2003



ALAN L. ROTMAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600